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| IVAN S. KAVRUKOV Cooper & Dunham LLP 1185 Avenue of the Americas New York, NY 10036 | | | EXAMINER ZURITA, JAMES II | |
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/601,961

Applicant(s)

TAKAHASHI, JUN

Examiner

JAMES ZURITA

Art Unit

3625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 June 2009.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 11-19 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 11-19 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/22)
4) ☐ Interview Summary (PTO-413)
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____
Paper No(s)/Mail Date _____

DETAILED ACTION

Response to Amendment

On 6/19/09, applicant cancelled claims 1-10 and added claims 11-19.

Claims 11-19 are pending and are examined.

Response to Arguments

Applicant's arguments filed 6/19/2009 have been fully considered but they are not persuasive.

Applicant argues that Exhibit A (remarks submitted 02/20/2009):

As plainly evident in Exhibit A, applicant pointed out in the Remarks (...) that the cited art (Adegawa) does NOT disclose or suggest the aspects of [arguments from 02/20/09]

- (a) registering a plurality of destinations
- (b) for each registered destination, allowing a **user** to set reporting timings at which the communication management report is to be transmitted to the registered destination and registering the **user**-set reporting timings for the registered destination and
- (c) the communication management report is transmitted to a selected destination at the user-set reporting timing for the selected destination.

In response to these arguments, the Examiner notes that the limitations are not in the claims. Claim 11 states, in relevant part, emphasis added,

allow a user to set reporting timings at which the communication management report is to be transmitted to the registered destination via electronic mail through said electronic mail communication part and register the set reporting timings for the registered destination,

...
transmitted to a selected destination at the user-set reporting timing for the selected destination.

Claim 11 refers to a part that allows a user to set parameters, but there is no mention of a user setting a timing or any other aspect of the report. The limitation is implied, not positively recited and appears to be outside the metes and bounds of the claims. As such, the limitation carries little to no patentable weight.

Applicant points to Adegawa, col. 5, lines 44-51, to support his argument:

Instead, the communications management report is output in Adegawa at [sic] proccaned [sic] timings [see column 5, lines 44-51] that are not set by the user.

The Examiner notes that the cited section of Adegawa does not support applicant's interpretation:

The communication management report is printed out on recording paper on the printer 105 in FIG. 1 each time a given time interval has elapsed or each time a given number of items are stored.

If a document transmitted from the Internet facsimile causes a transmission error to occur, a communication management report indicating non-transmission as shown as an output example in FIG. 4 is output. [Adegawa, col. 5, lines 44-51]

Further, the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

Applicant appears to rely for patentable distinction on his use of the term user. In response, during prosecution, claims are given their broadest reasonable interpretation:

USPTO personnel are to give claims their broadest reasonable interpretation in light of the supporting disclosure. In re Morris, 127 F.3d 1048, 1054-55, 44 USPQ2d 1023, 1027-28 (Fed. Cir. 1997). Limitations appearing in the specification but not recited in the claim should not be read into the claim. E-Pass Techs., Inc. v. 3Com Corp., 343 F.3d 1364, 1369, 67 USPQ2d 1947, 1950 (Fed. Cir. 2003) (claims must be interpreted "in view of the specification" without importing limitations from the specification into the claims unnecessarily). In re Prater, 415 F.2d 1393, 1404-05, 162 USPQ 541, 550- 551 (CCPA 1969). See also In re Zletz, 893 F.2d 319, 321-22, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989) ("During patent examination the pending claims must be interpreted as broadly as their terms reasonably allow.... The reason is simply that during patent prosecution when claims can be amended, ambiguities should be recognized, scope and breadth of language explored, and clarification imposed.... An essential purpose of patent examination is to fashion claims that are precise, clear, correct, and unambiguous. MPEP 2106.

Applicant refers to a user several times. For example:

For this purpose, according to the present invention, a configuration is made in a network facsimile apparatus in which a timing at which a report of communication management information is sent to a host apparatus or so can be set by a user or supervisory person even in various items in various ways, and, thus, the user/supervisory

person can obtain the information in various items in various ways according to the user's requirements. Accordingly, the user can perform management work concerning the operation of the network facsimile apparatus efficiently by collecting only necessary information without lack at the optimum timing. [disclosures, para. 11]

The Examiner notes that applicant provides no explicit definitions for the terms.

...Where an explicit definition is provided by the applicant for a term, that definition will control interpretation of the term as it is used in the claim. *Toro Co. v. White Consolidated Industries Inc.*, 199 F.3d 1295, 1301, 53 USPQ2d 1065, 1069 (Fed. Cir. 1999) (meaning of words used in a claim is not construed in a "lexicographic vacuum, but in the context of the specification and drawings."). Any special meaning assigned to a term "must be sufficiently clear in the specification that any departure from common usage would be so understood by a person of experience in the field of the invention." *Multiform Desiccants Inc. v. Medzam Ltd.*, 133 F.3d 1473, 1477, 45 USPQ2d 1429, 1432 (Fed. Cir. 1998). See also MPEP § 2111.01.

Since applicant has provided no explicit definition for the above terms, the Examiner relies on the term's ordinary meaning and broadest reasonable interpretation. *E-Pass Technologies, Inc. v. 3Com Corporation*, 343 F.3d 1364, 1368, 67 USPQ2d 1947, 1949 (Fed. Cir. 2003). The Examiner interprets the term user to include any a person that uses a portion of the claimed apparatus. Prior art is interpreted to meet the limitations where prior art discloses a user.

Drawings

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the

facsimile communication part
storage part
electronic mail communication part
report generation part

must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action.

The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 11-19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Applicant appears to rely for patentable distinction on his use of the term user, arguing that in Adegawa, timings are not set by the user.

Claim 11 refers to a part that allows a user to set parameters, but there is no mention of a user setting a timing or any other aspect of the report. The limitation is implied, not positively recited and appears to be outside the metes and bounds of the claims. As such, the limitation carries little to no patentable weight.

As before, prior art is interpreted to meet the limitations of the claimed apparatus where prior art discloses structure that is reasonably capable of performing the claimed functions. The Examiner interprets the term user to include any a person that uses a portion of the claimed apparatus. Prior art is interpreted to meet the limitations where prior art discloses a user.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 11 and 17, as best understood and as interpreted, are rejected under 35 U.S.C. 103(a) as being unpatentable over Adegawa (US 7230733) in view of Library Technology "Choosing a more productive, economical fax machine", Anonymous author, Library Technology Reports. Chicago: Mar/Apr 1998. Vol. 34, Iss. 2; pg. 235, downloaded from ProQuest on the Internet on 11/21/2009, 18 pages.

As per claim 11, Adegawa discloses a network facsimile apparatus (Figs. 1 and 2 and related text) comprising:

a facsimile communication part configured to perform facsimile communications (e.g., Adegawa, col. 1, lines 8-12),

a storage part configured to store communication management information concerning the facsimile communications performed by said facsimile communication part (e.g., Adegawa, col. 3, line 64-col. 4, line 5);

an electronic mail communication part configured to transmit electronic mails (e.g., Adegawa, Fig. 9 and related text; see also col. 7, lines 12-18);

a report generation part configured to generate a communication management report (e.g., Adegawa, col. 1, lines 60-67) utilizing at least some of the communication management information stored in said storage part (e.g., Adegawa, col. 1, lines 60-61,

...for example, date, time of day, associated party name, communication means, communication time, the number of transmitted sheets...

a communication management destination registration part configured to register a plurality of destinations (e.g., Adegawa, col. 6, lines 21-32, "...destinations..."; claim 1 "...plural destinations...", Adegawa, col. 1, lines 60-67, "...date, time...communication time..."), and

for each registered destination, that reporting timings at which the communication management report is to be transmitted to the registered destination via electronic mail through said electronic mail communication part and register the set reporting timings for the registered destination. E.g., Adegawa discloses that destinations are set, col. 6 lines 21-33; and

wherein the communication management report is transmitted to a selected destination at the set reporting timing for the selected destination (e.g., Adegawa, col. 8, lines 7-14).

Adegawa does not specifically disclose that a particular user sets the timings for the reports. Library Technology discloses allowing a user to set timings for the reports:

Programming is a major issue because each fax machine must be programmed for specifications like the time and date, autodial numbers, halfphone settings, etc. The fax machine should be easy to program and, preferably, tasks like entering autodial numbers and printing activity reports should be fairly intuitive for the user, who should be able to do this without having to consult user manuals every time. [Management Features, bottom of page 15]

It would have been obvious to one of ordinary skill in the art at the time of invention to have modified the invention of Adegawa to have included that a particular user sets the timings for the reports as taught by Library Technology because the incorporation of such features is no more than the predictable use of prior art elements according to their established function.

As per claim 17, Adegawa and Library Technology disclose that the communication management report comprises communication management information concerning occurrences of communication error. See, for example, Library Technology, page 16, second paragraph, "...what type of error occurred..."

Claims 12-16 and 18-19, as best understood and as interpreted, are rejected under 35 U.S.C. 103(a) as being unpatentable over Adegawa (US 7230733) in view of Library Technology and further in view of Official Notice.

As per claims 12-16, Adegawa and Library Technology do not specifically disclose that the communication management report generated by said report generating part is set to be transmitted at a reporting timing

when a total quantity of the communication management information in the storage part exceeds a predetermined amount (claim 12).
when a communication charge for a user reaches a predetermined amount (claim 13).
when a number of communications for a user reaches a predetermined value (claim 14).
when predetermined date and/or time arrives (claim 15).
when a number of communication failure exceeds a predetermined value (claim 16).

Official Notice is taken that it was old and well known at the time of applicant's invention to customize reports by a user. It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Adegawa, Library Technology and Official Notice to disclose that the communication management report generated by said report generating part is set to be transmitted at a reporting timing

when a total quantity of the communication management information in the storage part exceeds a predetermined amount (claim 12).
when a communication charge for a user reaches a predetermined amount (claim 13).
when a number of communications for a user reaches a predetermined value (claim 14).
when predetermined date and/or time arrives (claim 15).
when a number of communication failure exceeds a predetermined value (claim 16).

because the incorporation of such features is no more than the predictable use of prior art elements according to their established function.

As per claim 18, Adegawa and Library Technology do not specifically disclose that the mail title of the electronic mail transmitting the communication management report indicates a reason for the transmission. Official Notice is taken that it was old and well known at the time of applicant's invention to include a title (e.g., subject) in an email. It would have been obvious to one of ordinary skill in the art at the time the invention was made to disclose that the mail title of the electronic mail transmitting the communication management report indicates a reason for the transmission. One of

ordinary skill in the art would have been motivated to disclose that the mail title of the electronic mail transmitting the communication management report indicates a reason for the transmission for the obvious reason that providing a reason for the transmission in the mail title of an electronic mail message facilitate management and because the incorporation of such features is no more than the predictable use of prior art elements according to their established function.

As per claim 19, Adegawa and Library Technology do not specifically disclose that the communication management report is additionally transmitted by electronic mail to another destination for mail backup. Official Notice is taken that it was old and well known to one of ordinary skill at the time the invention was made to backup data, Including reports such as management reports because the incorporation of such features is no more than the predictable use of prior art elements according to their established function.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Eric Carr, Product comparison—Fax server software gets the fax right, Network Computing, Manhasset, 04/01/1995, p. 104, downloaded from ProQuest Direct on the Internet on 11/22/2009, 6 pages.

Peter Davidson, Fax servers send a cost-effective message, Network World, Southborough, 01/25/1993, vol. 10, iss. 4, p. 32, downloaded fro ProQuest Direct on the Internet on 11/22/09, 6 pages.

Steve Kalman, A new route for faxes, Network World, Southborough, 09/02/1996, vol. 13, iss. 36, downloaded fro ProQuest Direct on the Internet on 11/22/09, 4 pages.

Andre Kvitka, Fax servers lower costs, ease administration, Federal Computer Week, Falls CHurch, 02/08/1999, vol. 13, iss. 3, p. 34, downloaded fro ProQuest Direct on the Internet on 11/22/09, 9 pages.

Patrick Marshall, Fax Sr. surpasses RightFax in meeting the needs of the enterprise, InfoWorld, San Mateo, 08/11/1997, vol. 19, iss. 32, p. 104, downloaded fro ProQuest Direct on the Internet on 11/22/09, 5 pages.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JAMES ZURITA whose telephone number is (571)272-6766. The examiner can normally be reached on 8am-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey A. Smith can be reached on (571)272-6763. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/James Zurita/
James Zurita
Primary Examiner
Art Unit 3625
2 December 2009